

Notice of Allowability

Application No.

10/031,172

Examiner

Elena Tsoy

Applicant(s)

KOBAYASHI ET AL.

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to March 9, 2004.
2. ☒ The allowed claim(s) is/are 1-7.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date July 7, 2003
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Matthew on Jacob on March 22, 2004.

Claim 1, line 3, "which process is characterized in that" has been changed to -- wherein --.

Claim 1, lines 3-4, "said intermediate paint contains 0.5 to 5 phr of flat talc powder of a size" has been changed to -- said intermediate paint contains 0.5 to 5 phr of talc powder, said talc powder consisting essentially of flat talc powder of a size --.

Declaration under 37 CFR 1.132

2. The Declaration under 37 CFR 1.132 filed on March 9, 2004 is sufficient to overcome the rejection of claim 1 based upon Masuda et al (US 6,428,856) in view of Babler (US 5,648,408) with Ohtomo et al (US 5,475,049), Chase (US 3,102,856) and Ashton et al (US 3,684,197) to show inherent properties of talc.

Allowable Subject Matter

3. **Claims 1-7** are allowed.

The following is an examiner's statement of reasons for allowance: Claim 1 is allowed because the prior art of the record does not teach or suggest that inclusion into an intermediate

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paint of 40-100 phr of total pigment, which includes talc powder consisting essentially of flat talc powder having size of 0.5-10 microns in longer direction and 0.01-1 micron in thickness in an amount of 0.5-5 phr, provides a multilayer coating film with unexpectedly good chipping resistance and smoothness, as shown by the Declaration.

Iwato et al (submitted by Applicants with IDS of July 7, 2003) disclose that inclusion into an intermediate paint of 2-67 phr of total pigment, which includes 2-33 phr of ultrafine talc of less than 5 microns in longer direction and having more spherical shape than conventional talc powder, provides a multilayer coating film with an improved chipping resistance (See Abstract; column 5, lines 45-55). However, Iwato et al fail to teach or suggest that the ultrafine talc consisting essentially of flat talc having thickness of 0.01-1 micron and used in an amount of 0.5-5.0 phr, would provide the multilayer coating film with better chipping resistance and smoothness, as shown by the Declaration.

JP 55056165 (also submitted by Applicants with IDS of July 7, 2003) discloses a chipping resistant intermediate coating containing 30-100 phr of total pigment, which includes 20-50 phr of talc powder. In other words, JP 55056165 fails to teach or suggest that talc consisting essentially of flat talc having size of 0.5-10 microns in longer direction and thickness of 0.01-1 micron used in an amount of less than 5 phr would provide a multilayer coating film with an improved chipping resistance and smoothness, as shown by the Declaration.

Claims 2-7 are allowed as further limiting allowed claim 1.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

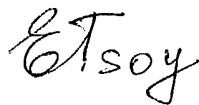
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Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Elena Tsoy
Examiner
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March 19, 2004